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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,678	11/06/2000	Webster Hughes	4530-1	8283
29858	7590	04/20/2004	EXAMINER	
BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,678

Applicant(s)

HUGHES, WEBSTER

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 3624

DETAILED ACTION

Note: The applicant's attorney (James Wood, Reg. 47184) over a telephone conversation (4/2/04) requested that the office action be mailed in order to respond to the election/restriction requirements.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17 are drawn to a method of executing business transactions wherein a plurality of parties receiving an order related to a business transaction designate a plurality of other parties with whom to communicate orders relating to the transaction.

II. Claims 18-33 are drawn to a method of executing business transactions wherein a plurality of parties communicate orders related to a business transaction with other parties, the orders having parameters set by the parties communicating the orders and wherein a chain of parties between a first party (communicating the order) and second ordering parties who have communicated orders relating to the orders is identified.

Art Unit: 3624

III. Claims 34-39 are drawn to a method of executing business transactions between a first party and a second party through a plurality of intermediaries which requires that information for identifying a list of other parties is stored in a memory accessible to the intermediary, the list is displayed to the intermediary who is allowed to select one or more parties from the list and the order is communicated from the intermediary to the one or more parties.

IV. Claims 40-45 are drawn to a method of execution of transactions based upon an order communicated by a first investor to a broker dealer who decides whether to match the presented order or communicate an order relating to the transaction to a plurality of other parties. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a plurality of parties receiving an order related to a business transaction designate a plurality of other parties with whom to communicate orders relating to the transaction. See MPEP § 806.05(d).

Art Unit: 3624

SPECIES:

The applicant is required to elect among the following species depending upon election of the one of the aforementioned Inventions:

If invention I is elected, one of the following species of the generic invention indicated in the bracket must be elected.

Claims 1-3 and (4 or 5) and 6-9 and (10 or 11-12) and (13 or 14), 15 and 16.

If invention II is elected, one of the following species of the generic invention indicated in the bracket must be elected.

Claims 18-24 and (25 or 26-27) and (28 or 29) and 30-33.

If invention III is elected, one of the following species of the generic invention indicated in the bracket must be elected.

Claims 34-35, and (36 or 37 or 38-39).

If invention IV is elected, one of the following species of the generic invention indicated in the bracket must be elected.

Claims 40, and (41, or 42-44, or 45).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held

Art Unit: 3624

to be allowable. Currently, claims 1, 18, 34 and 40 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or

Art Unit: 3624

admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

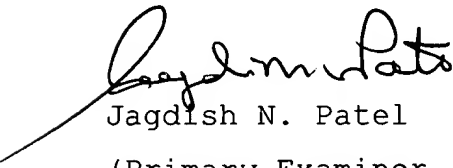
In the event applicant elects the aforementioned species, Applicant is further required to provide where support in the descriptive portion of the specification may be found to support such an election.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) ⁸⁷²⁻⁹³⁰⁶~~305-7687~~. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Primary Examiner, AU 3624)

(4/1/04)